



CPW  
1733  
\$

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANTS: Shin-Ichi Yamaguchi et al.  
SERIAL NO: 10/032,741  
FILED: October 22, 2001 Atty Docket No. 505500-62  
TITLE: A Method for Manufacturing a Belt  
Examiner: John L. Goff II Art Unit: 1733

**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT**

**UNDER 37 CFR 1.702(b) AND 1.705(d)**

Mail Stop Patent Ext.  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants hereby request reconsideration of the patent term extension in the Issue Notification, copy attached. The Issue Notification shows that the patent based on the above-entitled application will issue on June 7, 2005. The application was filed on October 22, 2001. The patent is issuing more than 3 years after the filing of the application, i.e., by 228 additional days after the end of the required 3 year period, ending on October 22, 2004, under 37 CFR 1.702(b). The Issue Notification states that the term of adjustment is 138 days, the same period as indicated in the Notice of Allowance. This is error as the patent term should have

been adjusted prior to issuance of the Issue Notification to account for the fact that the patent is issuing more than 3 years after the filing date of the corresponding application due to PTO delay in prosecuting the application.

37 CFR 1.702(b) states:

“the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed. . .”

37 CFR 1.705(b) states that:

“Any request for reconsideration of the patent term adjustment indicated in the notice of allowance, except as provided in paragraph (d) of this section, . . . must be by way of an application for patent term adjustment under this section must be filed no later than the payment of the issue fee but may not be filed earlier than the date of mailing the notice of allowance.

37 CFR 1.705(d) states:

“If there is a revision to the patent term adjustment indicated in the notice of allowance, the patent will indicate the revised patent term adjustment. If the patent indicates or should have indicated a revised patent term adjustment, any request for reconsideration of the patent term adjustment indicated in the patent must be filed within two months of the date the patent issued and must comply with the requirements of paragraphs (b)(1) and (b)(2) of this section. Any request for reconsideration under this section that raises issues that were raised, or could have been raised, in an application for patent term adjustment under paragraph (b) of this section shall be dismissed as untimely as to those issues.” (underlining added)

Applicants could not comply with section 1.705(b) with respect to the issuance of

the patent, since the notice of allowance does not indicate the issue date of the patent, which is dependent upon payment of the issue fee. Section 705(d) does not take into consideration the facts of present situation wherein under section 702(b) the term should be extended due to issuing the patent more than 3 years after filing.

Section 705(b) is not appropriate for the situation wherein a patent issues more than 3 years after the original filing date of the application as the issuance of a patent can not occur until the issue fee is paid, and, under the spirit of sections 702(b) and 705(d), patent term adjustment is appropriate.

Section 705(d) states that it applies

“If there is a revision to the patent term adjustment indicated in the notice of allowance.”

There was no such revision, nor there could have been, because the patent term adjustment for the PTO issuing a patent beyond 3 years after the original filing date could not be ascertained at the time the notice of allowance was issued, but until only after the issue fee is paid and issue notification provided. The patent term adjustment is counted on a day to day basis and, without knowledge of the actual issuance date of the patent, no revision of the notice of allowance on this basis could have been requested or made. This paper is being filed at the first instance that such a request could be made for a patent term adjustment based

on the patent issuing more than 3 years after the application was originally filed under section 702(b).

Notwithstanding the first sentence of section 705(d), the second sentence, which is apropos, states:

If the patent indicates or should have indicated a revised patent term adjustment, any request for reconsideration of the patent term adjustment indicated in the patent must be filed within two months of the date the patent issued and must comply with the requirements of paragraphs (b)(1) and (b)(2) of this section. (underlining added).

This sentence deals with the current situation notwithstanding the inappropriateness of the first sentence discussed above. The Issue Notification and the patent should indicate a revised patent term, which revision could not have been entered on the notice of allowance, and thus this is the first opportunity to enter such a revised patent term, and such a revision was not in fact made on the Issue Notification. The patent term of 138 days on the Issue Notification is identical to the term on the notice of allowance and is wrong as the correct term is 228 days. This term could not have been noted in the notice of allowance for the reason stated above. This paper is being filed within two months of the Issue Notification and issuance of the patent and thus is timely under 37 CFR 1.705(d).

A check in the amount of \$200 is enclosed for the fee for this paper under §1.18(e), § (705(b)(1).

The facts regarding the prosecution showing the delay in issuing the patent

is due to PTO delay under § (705(b)(2) are as follows.

(2)(i) The correct term adjustment under § 702 is 228 days.

(ii) The relevant dates to which the patent is entitled are that it should have issued by October 22, 2004 based on a file date of October 22, 2001 and is issuing on June 7, 2005.

(iii) There is no terminal disclaimer.

(iv)(B) There were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704 as shown below.

The facts, in particular, are as follows:

5/2/03	Non-final action issued. Applicants responded within 3 months on June 27, 2003.
9/16/03	Second non-final action issued. Applicants responded within 3 months on December 8, 2003. A minor amendment was made to a dependent claim to respond to an informality rejection and no amendment was made to the sole independent claim.
3/10/04	Final Action issued with new grounds of rejection.
3/29/04	Applicants file a request to withdraw the finality of the final rejection as premature.
4/26/04	Applicants file a response to the final rejection.
6/8/04	Advisory Action is mailed denying request to withdraw finality of Office Action of 3/10/04.
6/21/04	Applicants file a Petition under 37 CFR 1.181 to withdraw

finality of final Office Action and are required to file an extension of time. The advisory was received by our office docketing section on June 10 as is our normal office business procedure. On 6/16/04 a letter is written to the client in Japan (the client is a Japanese entity) for approval of the petition and approval for its filing as is required for this client. The petition could in no circumstances have been filed on June 10 due to the lateness of the Advisory Action mailing, which is more than two months after filing the request to withdraw the finality of the final rejection and which should have been acted on by the PTO in 10 days of filing the request to withdraw the finality, since this was an after final paper.

- 7/6/04      Response to Final Action amending the claims and to the Advisory Action is filed. A Notice of Appeal is also filed, as it is not known how long the PTO would take to decide the petition to withdraw the finality of the final rejection and the clock is running on the 3/10/04 final Action. The Notice of Appeal is reasonable as is the extension of time filed on June 21 in view of the PTO delays. It turns out this is a correct course of action, since the decision on petition is not mailed until August 30, 2004. This paper is first docketed by our office docketing section on 9/10/04, 6 months from the mailing of the final rejection of 3/10/04 and too late to reasonably communicate with the client in Japan as to a course of action.
- 9/2/04      A new final Action is issued raising a new grounds of rejection.
- 11/15/04    An RCE is filed with amended claims. The filing of the RCE did not delay the term of issuing the patent as the PTO could have timely issued the substance of the 9/2/04 final Action earlier so that the patent could have issued within 3 years of filing.
- 1/14/05      A notice of allowance issues.

A review of the above shows that applicants timely responded to each and



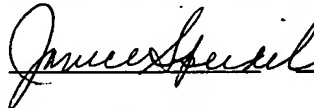
every paper issued by the PTO and the delay in issuing the patent is due solely to the actions of the PTO. Accordingly, applicants respectfully request that the patent term be adjusted to 228 days.

The Commissioner is authorized to charge any additional fees due for this paper or credit any overpayments to Deposit Account No. 03-0678.

**FIRST CLASS CERTIFICATE**


I hereby certify that this correspondence is being deposited today with the U.S. Postal Service as First Class Mail in an envelope addressed to:

Mail Stop Patent Ext.  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

 5/25/2005

Janice Speidel                      Date

Respectfully submitted,  
Shin-Ichi Yamaguchi et al.

By:   
William Squire, Reg. No. 25,378  
Attorney for Applicants

Phone: 973-994-1700  
Fax: 973-994-1744

201968v5



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	ISSUE DATE	PATENT NO.	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,741	06/07/2005	6902640	505500-62 FP13-1343	6398

27162 7590 05/18/2005

CARELLA, BYRNE, BAIN, GILFILLAN, CECCHI,  
STEWART & OLSTEIN  
5 BECKER FARM ROAD  
ROSELAND, NJ 07068

## ISSUE NOTIFICATION

The projected patent number and issue date are specified above.

**Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)**  
(application filed on or after May 29, 2000)

The Patent Term Adjustment is 138 day(s). Any patent to issue from the above-identified application will include an indication of the adjustment on the front page.

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571) 272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (703) 305-8283.

APPLICANT(s) (up to 18 names are included below, see PAIR WEB site <http://pair.uspto.gov> for additional applicants):

Shin-Ichi Yamaguchi, Tokyo, JAPAN;  
Hiroyuki Asano, Saitama-ken, JAPAN;  
Masateru Fujimori, Shizuoka-ken, JAPAN;

DATE RECEIVED:	5-23-05
DATES ENTERED:	
1)	12-7-2005
2)	12-7-2012
3)	12-7-2012
4)	12-7-2012
5)	
6)	
DOCKETED BY:	PM
DATE:	5-23